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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,779	04/21/2004	Robert P. Bourdelais	85924PAL	5242

7590

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/828,779	BOURDELAIS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Patricia L. Nordmeyer	1772	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5, 6 and 8-25 is/are pending in the application.
- 4a) Of the above claim(s) 20-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 8-19 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Withdrawn Rejections***

1. The 35 U.S.C. 112 2<sup>nd</sup> paragraph rejection of claims 1 – 19 in the office action dated February 14, 2006 is withdrawn due to Applicant's amendments and arguments in the response dated June 16, 2006.
2. The 35 U.S.C. 102(b) rejection of claims 1 – 4, 6, 8 – 12 and 14 – 16 as anticipated by Aoki et al. in the office action dated February 14, 2006 is withdrawn due to Applicant's amendments and arguments in the response dated June 16, 2006.
3. The 35 U.S.C. 102(e) rejection of claims 1 – 4, 6, 8 – 12 and 14 – 16 as anticipated by Aoki et al. in the office action dated February 14, 2006 is withdrawn due to Applicant's amendments and arguments in the response dated June 16, 2006.
4. The 35 U.S.C. 103(a) rejection of claims 5, 7 and 17 over Aoki et al. in view of Reiger et al. in the office action dated February 14, 2006 is withdrawn due to Applicant's amendments and arguments in the response dated June 16, 2006.
5. The 35 U.S.C. 103(a) rejection of claims 13, 18 and 19 over Aoki et al. in view of Tsugawa et al. in the office action dated February 14, 2006 is withdrawn due to Applicant's amendments and arguments in the response dated June 16, 2006.

***Terminal Disclaimer***

6. The terminal disclaimer filed on June 16, 2006 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 10/780,263 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Election/Restrictions***

7. Applicant's election with traverse of Group I, claims 1 - 19 in the reply filed on June 16, 2006 is acknowledged. The traversal is on the ground(s) that method claim does not include perforations and therefore the alternative method would be satisfactory and within the claims. This is not found persuasive because the Examiner stated another materially different product that could be made using the claimed method limitations. The materially different product does not have to be within the claim limitations.

The requirement is still deemed proper and is therefore made FINAL.

***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting

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ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1 – 19 and 25 are provisionally rejected on the ground of nonstatutory

obviousness-type double patenting as being unpatentable over claims 1 - 41 of copending

Application No. 10/783,411. Although the conflicting claims are not identical, they are not

patentably distinct from each other because both applications claim an article having a base made

of a compliant material, a closed cell foam core sheet, having an adhesive layer a sheet that accepts printing.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 – 12 and 14 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. (USPN 6,562,429) in view of Reiger et al. (USPN 6,653,061).

Aoki et al. discloses a label stock (Column 1, lines 30 – 33) comprising in order at least

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one pragmatic sheet (Figures 1 – 3, #1), a pressure sensitive adhesive (Column 3, lines 29 – 31; Figure 1, #2) having a thickness between 5 and 100 micrometers, thereby overlapping the claimed range of 12 and 25 micrometers, (Column 7, lines 11 – 14) and a compliant carrier sheet (Figures 1 – 3, #3), wherein the compliant carrier sheet comprises at least one voided layer (Column 2, lines 41 – 42 – wherein the cells of the foam layer are equivalent to the voids) adjacent said adhesive (Figure 1, #2 and 3; Column 6, lines 40 – 43) as in claims 1, 4, 6 and 12. Regarding claims 2, 3 and 8 – 11, the compliant carrier sheet would inherent recover to 90% of the original thickness after compression of between 25 and 50% of the original thickness, recover 95% of the original thickness in less than 2 seconds after removal of load, having a compliant factor of between 20 and 100 micrometers measured at 1.2 MPa, have a modulus of at least 2500 MPa, be reflective to collimated light energy and have a surface resistivity of less than 10<sup>12</sup> ohms per square since the compliant is an air voided polymer layer (Column 2, lines 41 – 42 – wherein the cells of the foam layer are equivalent to the voids). The pragmatic sheet comprises either cellulose paper or is substantially transparent (Column 3, lines 18 – 25) and would inherently have a bulk modulus of 2000 to 100,000 MPa. However, Aoki et al. fail to disclose a polyester polymer sheet having at least one voided layer, a release layer between said adhesive and said voided layer and the pragmatic sheet comprising a gelatin layer adjacent to said adhesive.

Reiger et al. teach a polyester polymer sheet (Column 10, lines 10 – 13) having at least one voided layer (Column 10, lines 66 to Column 11, line 11), a release layer between said adhesive (Column 18, lines 19 – 27) and said voided layer and the pragmatic sheet comprising a

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gelatin layer adjacent to said adhesive (Column 7, lines 9 – 17) in a label stock (Column 1, lines 6 – 9) for the purpose of forming a label that is low in cost and has excellent optical properties (Column 10, line 66 to Column 11, line 1).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the polyester polymer sheet and gelatin layer in Aoki et al. in order to form a label that is low in cost and has excellent optical properties as taught by Reiger et al.

12. Claims 13, 18, 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki et al. (USPN 6,562,429) in view of Reiger et al. (USPN 6,653,061) as applied to claims 1 – 12 and 14 – 17 above, and further in view of Tsugawa et al. (USPN 5,928,987).

Aoki et al., as modified with Reiger et al., discloses a label stock comprising in order at least one pragmatic sheet, a pressure sensitive adhesive having a thickness between 5 and 100 micrometers, thereby overlapping the claimed range of 12 and 25 micrometers, and a compliant carrier sheet, wherein the compliant carrier sheet comprises at least one voided layer adjacent said adhesive and a release layer. However, the modified Aoki et al. fail to disclose the pragmatic sheet comprising a thermal dye receiver layer or an ink jet receiver layer.

Tsugawa et al. teach a pragmatic sheet comprising a thermal dye receiver layer (Column

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7, lines 4 – 6; Column 2, lines 42 – 47) or an ink jet receiver layer (Column 6, lines 63 – 66) in a label stock (Column 7, line 5) for the purpose of forming a recording material that is superior in sensitivity and image durability while having good resistance to heat and moisture (Column 2, lines 22 – 25).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the thermal dye receiver layer or ink jet receiver layer in the modified Aoki et al. in order to form a recording material that is superior in sensitivity and image durability while having good resistance to heat and moisture as taught by Tsugawa et al.

### ***Response to Arguments***

13. Applicant's arguments with respect to claims 1 – 19 and 25 have been considered but are moot in view of the new ground(s) of rejection. However, since the same prior art is being applied in the above rejections, the arguments will be responded to below.

In response to Applicant's argument that Aoki et al. does not anticipate the invention as claimed as there is no release layer between the adhesive and the voided layer below pragmatic sheet, please see the newly presented argument above.

In response to Applicant's argument that Reiger et al. does not disclose a sheet having cushioning properties of the claimed invention or the location of a release layer and a pressure sensitive adhesive above the cushioning layer and beneath the pragmatic sheet, Reiger et al.



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teach a polyester polymer sheet (Column 10, lines 10 – 13) having at least one voided layer (Column 10, lines 66 to Column 11, line 11), a release layer between said adhesive (Column 18, lines 19 – 27) and said voided layer and the pragmatic sheet comprising a gelatin layer adjacent to said adhesive (Column 7, lines 9 – 17) in a label stock (Column 1, lines 6 – 9). The applicant clearly states in their response dated June 16, 2006 on page 6 that the compliant material can be a voided film, which is disclosed by Reiger et al.

In response to Applicant's argument that Tsugawa et al. does not overcome the disadvantages of the Aoki et al. material, please see the newly presented rejections and arguments above.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
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*Nasser Ahmad*  
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PRIMARY EXAMINER 8/10/06